

fluid diverter member 4. The following excerpt from pages 9-10 of applicant's application fully explains this:

To enhance the flow of liquid from the container, a flow channel or groove 12 is preferably formed in the middle of the internal wedge, thus providing the liquid with a specific flow channel. The flow channel 12 is positioned and configured to assist the fluid diverter member 4 in compelling fluid through the sipping region 16A. As shown most clearly in Figure 1C, the flow channel 12 preferably extends lengthwise along an outer surface of the fluid diverter member 4. The channel is preferably continuous from the bottom 6 of the container 2 to the extension spout 8, in order to help prevent spillage as the container is emptied. In the preferred embodiment shown in Figure 1C, the flow channel comprises a lengthwise groove formed by a pair of curved walls 13A, 13B.

(Original specification page 9, line 14 to page 10, line 5). The examiner states that the drawing objection can be resolved by changing the word "outer" in line 2 of claim 3 to "inner" or "upper" and by changing the word "outer" in line 12 of claim 8 to "inner" or "upper." (Page 3) Applicant declines to make the change. As explained in further detail in the following section, there is a very good reason why applicant has chosen to call the area in question an "outer" surface, rather than an "inner" or "upper" surface.

In any event, a change in claim terminology is certainly immaterial to whether the drawings show the claimed subject matter. There is no question whatsoever that the drawings clearly and unambiguously show a flow channel 12 extending along an outer surface of the fluid diverter member 4. Applicant's petition on this issue has been granted, and it should no longer be raised as a ground of objection.

### **Objection to Claims 3 and 8-10**

Claims 3 and 8-10 are objected to as reciting structure pertaining to the flow channel extending along an outer surface of the fluid diverter member, which the Examiner states has not been shown in the drawings. (Page 2). As with the objection to

the drawings, the examiner notes that the foregoing claim objection can be resolved by

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changing the word “outer” in line 2 of claim 3 to “inner” or “upper” and by changing the word “outer” in line 12 of claim 8 to “inner” or “upper.” (Page 3). Applicant declines to make the change. The grounds of this objection were disposed of by the Commissioner’s decision on applicant’s petition.

As applicant has previously noted, he is free to be his own “lexicographer.” There is a reason why applicant has used the word “outer,” as can be seen from the following excerpt from Page 9 of applicant’s specification:

As shown in Figure 1A, the vessel 2 includes a fluid diverter member 4 disposed generally along one side of the container 2. The fluid diverter member 4 is contiguous with an inner surface and the bottom 6 of the vessel 2, such that fluid cannot seep behind the fluid diverter member 4. The diverter member 4 slopes downward substantially from the sipping region 16A of the rim toward an opposing side of the vessel such that when the bottom 6 of the vessel 2 is pivoted upward about the sipping region 16A of the rim 16, the diverter member 4 compels fluid through the sipping region 16A, and into the mouth of a user. As shown in the side view of Figure 1A, the fluid diverter member 4 is preferably wedge shaped. Because of the fluid diverter member 4, the cup or container 2 will empty with a minimal tilting angle. This internal wedge 4 forces all liquid in the container against the opposing wall of the container 2. The wedge member 4 can also be provided in the form of a preformed insert that is sized to fit into an existing drinking container, such as a conventional coffee cup or mug.

(Original specification, page 8, line 8 to page 9, line 2). This paragraph describes the fluid diverter members 4 as a generally wedge shaped member that is disposed inside of a drinking vessel such as a cup. Obviously, by the way the fluid diverter member 4 is described above (including but not limited to the way the fluid diverter member 4 is described with reference to the drawings), the fluid diverter member 4 has only one surface that is exposed; this exposed surface is the “outer” surface. The outer surface is exposed inside of the cup and serves, when the cup is pivoted upward about the sipping region, to compel liquid in the cup through the sipping region and into the mouth of a

user. All of this is made clear by the foregoing excerpt from applicant's specification. However, if there is any doubt as to the location of the "outer" surface, it is laid to rest by the following paragraph from applicant's specification, which clearly and unambiguously explains how a flow channel 12 positioned on the outer surface of the fluid diverter member 4 can enhance the function of the fluid diverter member 4:

To enhance the flow of liquid from the container, a flow channel or groove 12 is preferably formed in the middle of the internal wedge, thus providing the liquid with a specific flow channel. The flow channel 12 is positioned and configured to assist the fluid diverter member 4 in compelling fluid through the sipping region 16A. As shown most clearly in Figure 1C, the flow channel 12 preferably extends lengthwise along an outer surface of the fluid diverter member 4. The channel is preferably continuous from the bottom 6 of the container 2 to the extension spout 8, in order to help prevent spillage as the container is emptied. In the preferred embodiment shown in Figure 1C, the flow channel comprises a lengthwise groove formed by a pair of curved walls 13A, 13B.

(Original specification, page 9, line 14 to page 10, line 5). As can be clearly seen from the foregoing description and accompanying drawings, the fluid diverter member 4 has one exposed surface or side, namely the "outer" surface. In a preferred embodiment, a flow channel or groove 12 is formed on this outer surface. A person of skill in the art, upon reading the specification and looking at the drawings, will understand that the claimed features are shown in the drawings.

Only by ignoring the specification and drawings can it be said that structure pertaining to the flow channel 12 extending along an outer surface of the fluid diverter member 4 is not shown in the drawings. For the foregoing reasons, the claimed feature of a flow channel 12 extending along an outer surface of a fluid diverter member 4 is clearly and unambiguously shown in the drawings. Applicant's petition on this issue has been granted, and it should no longer be raised as a ground of objection.

### **Rejection of Claims 3 and 8-10 under 35 U.S.C. § 112**

Claims 3 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. In particular, the examiner takes the position that the only flow channels designated in the specification by reference number 12 are substantially inner upper surfaces. As with the foregoing claim and drawing objections, the examiner states that the claim rejection under § 112 can be resolved by changing the word "outer" in line 2 of claim 3 to "inner" or "upper" and by changing the word "outer" in line 12 of claim 8 to "inner" or "upper." (Page 3). Applicant declines to make the amendment.

The Examiner bears the burden of showing that the proposed claim language is indefinite to one of skill in the art. The Examiner has not met this burden, and has not even attempted to do so, other than to suggest that applicant change the word "outer" to "inner" or "upper" in the rejected claims. However, changing the word "outer" to "inner" or "upper" is not going to make claims 3 and 8-10 any more clear than they already are. The law is clear that if the claims, read in light of the specification, reasonably apprise those skilled in the art of the use and scope of the invention, and if the language is as precise as the subject matter permits, the claims are definite under § 112, ¶ 2. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985). For the reasons discussed above, there is no question that a person of skill in the art, upon reading applicant's claims in view of the specification, will understand exactly what applicant is claiming.

### **Rejection of Claims 1-10 Under 102(b) as Anticipated by Neville and Dixon**

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Neville and Dixon, Sr. et al. ("Dixon"). (Pages 3-5).

Anticipation under 35 USC 102(b) requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 58 USPQ.2d 1286, 1291 (Fed.Cir.2001); MPEP § 2131. To establish a prima facie case of anticipation under 35 USC 102(b), the Examiner must identify the elements of the claims of the application, determine their meaning in light of the specification and prosecution history, and identify the corresponding elements disclosed in the allegedly anticipating references. *Lindermann Maschinenfabrick GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). If the Examiner does not produce a prima facie case of anticipation, then the applicant is entitled to the grant of a patent. *In re Oetiker*, 24 USPQ.2d 1443 (Fed. Cir. 1992).

Neither Neville nor Dixon disclose each and every element of the claimed invention. Among other things, Neville and Dixon completely fail to disclose the claimed fluid diverter member 4. Neville and Dixon each disclose only an ordinary drinking vessel having inwardly sloping walls. Only by ignoring applicant's specification (see e.g. page 8, line 8 to page 9, line 2) and drawings (Figures 1A, 1C, 2B, 3A, 3B, 4A), while simultaneously reading the teachings from applicant's specification and drawings into the cited references, can the inwardly slopping walls of Neville and Dixon somehow be construed as disclosing the claimed "fluid diverter member." A §102(b) reference must place the needed subject matter supporting the anticipation rejection in the public

domain. *In re Zenitz*, 333 F.2d 924, 142 USPA 158, 160 (CCPA 1964). The §102(b) reference must be such that a person of ordinary skill in the field of the invention would consider there to be no difference between the claimed invention and the reference disclosure. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ.2d 1001, 1010 (Fed. Cir. 1991). In other words, the §102(b) reference must put the claimed invention in the hand of one skilled in the art. *In re Spada*, 911 F.2d 705, 708, 15 UAPQ.2d 1655, 1657 (Fed. Cir. 1990; *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). The description from the §102(b) reference must enable a person with ordinary skill in the art not only to comprehend the invention but also to make it. *Paperless Accounting, Inc. v. Bay Area Rapid Transit System*, 804 F.2d 659, 665 (Fed. Cir. 1986), cert. den. 480 U.S. 933 (1987).

Under no stretch of the imagination can it be said that the Neville and Dixon references place the claimed invention in the hands of a person of ordinary skill in the art. The Neville and Dixon references make absolutely no reference to a drinking vessel having a structure therein for compelling fluid through a drinking area. All the references show is a drinking vessel having walls that uniformly slope inward. Applicant again refers the Examiner to Figures 1A, 1C, 2B, 3A, 3B, and 4A of his application, in which the claimed fluid diverter member 4 is shown in great detail. Applicant further refers the Examiner to his specification, including particularly pages 8-10. These portions of applicant's application describe a "fluid diverter member 4" that differs markedly from a drinking container having inwardly sloping walls. The fact that applicant has included broad claims to a fluid diverter member should not prevent him from obtaining issuance of such claims, particularly when a fluid diverter member is not even found in the prior

art. Applicant is entitled to have his claims interpreted in light of the description set forth in applicant's specification and drawings, not in a vacuum based on improper hindsight reconstruction of the invention.

Because neither Neville nor Dixon discloses each and every element of the claimed invention, it is respectfully submitted that a prima facie case of anticipation by Neville or Dixon has not been established.

**Rejection of Claims 1-6 and 8-10 under 102(b) as anticipated by Watson**

Claims 1-6 and 8-10 have rejected under 35 U.S.C. 102(b) as being anticipated by Watson.

Applicant respectfully submits that Watson does not anticipate claims 1-6 and 8-10. Watson differs markedly from the present invention because it does not disclose several features of the claimed invention. Because Watson does not disclose each and every element of the claimed invention, arranged as in the claims, it is respectfully submitted that the Examiner has not established a prima facie case of anticipation under 35 USC 102(b).

Independent claims 1 and 8 recite a "fluid diverter member contiguous with an inner surface and said bottom of said vessel, said diverter member sloping downward...from said sipping region...toward an opposing side of said vessel such that when said bottom of said vessel is pivoted upward about said sipping region...said diverter member compels fluid through said sipping region." Claims 2, 4 and 6, which are dependent on claim 1, and claim 9, which is dependent on claim 8, also include the fluid diverter member recited in their corresponding independent claims. None of these claimed features are shown in the Watson reference.

The Examiner has not identified any of the elements of the claims of the application, particularly the fluid diverter member, or the corresponding elements disclosed in the cited anticipating reference. Accordingly, the absence of a fluid diverter member in Watson is sufficient to overcome the grounds for the 102(b) rejection.

Moreover, Watson relates to a drinking vessel comprising a spout that projects laterally from one side of the vessel near its open upper end. Both Watson's disclosure and claims expressly recite a vessel comprising "a main body of generally hollow form having a closed bottom end, a generally uninterrupted peripheral side wall formed about a generally centered vertical axis, and terminating in an upper end." This description of the main body of Watson's vessel necessarily prohibits the inclusion of a fluid diverter member sloping downward from the sipping region toward an opposing side of the vessel.

For these reasons, the applicant submits that a prima facie case of anticipation has not been established as to claims 1-6 and 8-10 and it is respectfully suggest that the claims are allowable over the art of record.

**Rejection of Claims 4, 5, 9 and 10 Under 103(a) Over Neville/Dixon in View of Rosen**

Claims 4, 5, 9 and 10 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Neville or Dixon in view of Rosen.

The Examiner bears the initial burden of factually supporting a prima facie conclusion of obviousness. MPEP § 2142. If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. *Id.*



To establish a prima facie case of obviousness, the examiner must demonstrate: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings; (2) a reasonable expectation of success; and (3) that the references teach or suggest all of the claim limitations. *Id.*

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicant suggests that the Examiner has not made a prima facie case as to claims 4, 5, 9 and 10 because neither Neville nor Dixon in combination with Rosen teaches or suggests all the claim limitations, including without limitation a fluid diverter member.

The lack of a fluid diverter member in Neville and Dixon was discussed *supra*. Rosen relates to a leak resistant drink box holder, which by necessity includes a straw to evacuate the contents of the drink box. A fluid diverter member as claimed in the application would serve no purpose in the invention disclosed in Rosen for two reasons. First, Rosen's drink box holder does not hold fluid, but instead holds a solid drink box; therefore, there is no fluid in the vessel that requires diverting. Second, since a straw is required to evacuate the contents of the drink box, pivoting the drink box holder would not result in the fluid diverter member compelling liquid through the sipping region, but instead would result in the failure of the straw to maintain a liquid seal and the inability to evacuate the drink box.

Based on the foregoing, the cited references not only fail to teach or suggest all of the claim limitations, namely the fluid diverter member, but also teach away from the

inclusion of such a limitation in their respective inventions. Therefore, applicant submits that no prima facie case of obviousness has been established as to claims 4, 5, 9 and 10, and it is respectfully suggested that the claims are allowable over the art of record.

### **Conclusion**

For the reasons explained above, applicant suggests that claims 1-10 are allowable over the art of record and requests that the Examiner's rejections be withdrawn. It is believed that no additional fees are due, but if any additional fees are due, the Commissioner is authorized to charge them to Deposit Account No. 502346.

Respectfully submitted,



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